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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/856,362

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Dominique Hamoir

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07/28/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

PASCAL, LESLIE C

ART UNIT

PAPER NUMBER

2613

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 09/856,362	Applicant(s) HAMOIR, DOMINIQUE	
	Examiner Leslie Pascal	Art Unit 2613	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 11 July 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

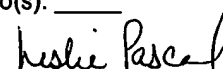
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


 Leslie Pascal
 Primary Examiner
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In regard to the applicant's arguments with regard to "single means", the applicant argues that there must be a "means recitation to invoke the single means prohibition".

The section 2164.08(a) of the MPEP cites IN RE HYATT. The following is a quote from IN RE HYATT, (CAFC, 218 USPQ 195), on page 196.

The board noted at that time that claim 35 is a so-called "single means claim," that is, a claim drafted in "means-plus-function" format yet reciting only a single element instead of a combination. The board therefore entered a new rejection of claim 35 under 37 CFR 1.196(b); based on the second paragraph of 35 USC 112, ²for failure to particularly point out and distinctly claim the subject matter which appellant regarded as his invention. The board noted that the final paragraph of §112 ³sanctions the use of the means-plus-function format for combination claims only. From that fact, coupled with appellant's attempted use of that format in claim 35, the board inferred that appellant had intended to claim a combination. Because claim 35 does not recite a combination, however, the board reasoned that it does not recite that which appellant *intended* to claim, and, hence, entered the new rejection. The board then reversed the §102 rejection, asserting that "the metes and bounds of the claimed invention set forth in claim 35, can only be determined through speculation as to the elements included in the implied combination of elements," so that it could not be said whether the reference relied upon by the examiner in fact anticipated the claimed invention.

In the first sentence, it says that a single means claim is drafted as a "means plus function" format reciting only a SINGLE ELEMENT instead of a combination. The case law is quite clear that it is referring to a single element. There is no requirement for the term "means" to be in the claim.

IN RE HYATT goes on to say on page 197:

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“To set forth at the outset what should be apparent, claim 35 is a single means claim. It is not disputed that it is drafted in means-plus-function format, and it is not disputable that it is drawn to a single element. A mere *recital* of a multitude of elements or steps in a claim is not determinative of the *invention* it defines. A claim must be read in accordance with the precepts of English grammar. In claim 35, the invention defined is what follows the word "comprising." Indeed, appellant has admitted that claim 35 is drawn to only a single element when he asserts that it is not drawn to a combination. Appellant's denomination of every noun in the claim as a separate element ignores the fact that these words function as mere description of the single claimed means.”

It is clear from IN RE HYATT that a single element is considered a single means.

On page 3 of the applicant's argument, the applicant argues “there are no claims in this application directed to the fiber itself”. In claim 24, the only means (element) claimed in a fiber. The arguments on this page refer to depletion and enrichment of the Raman effect of the fiber. It goes on to say that the fiber compensates for these depletions and enrichments. The examiner has asked specifically twice that if the fiber “causes and fixes the problems, is there really a problem?”. The applicant has never answered this question. There are no other means in the claim to cause or fix the problem. The applicant requests that the examiner “point out more particularly what is recited in claim 24 that one of skill in the art would not be able to do” given what is described in the specification. The applicant claims a single element (means-see IN RE HYATT). Further, fiber is the cause of depletion and enrichment, yet in the applicant's claims, it

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is compensating. If the fiber is causing and fixing the problem-is there a problem? As claimed, a well-known fiber is causing and fixing the problem. Why doesn't other fiber provide this function? Nothing in the claim makes it clear why or how the applicant's invention is novel. This is the problem with single means claims. There is no combination to provide the function.

On page 4 of the arguments, the applicant argues that page 9, line 27 explains the enrichment compensation and page 11, lines 31-33 discusses distributed amplifiers. In regard to page 9, line 27, there is no mention of distribution. In regard to page 10, although line 4 mentions distributed amplifiers, this does not say that the distributed amplifiers are providing the compensation but the power used with either distributed amplifiers or discrete amplifiers. Further, lines 4-15 provide compensation using the transmission fiber, which appears to have the same problems as claim 24. The fiber is causing the problems and compensating for the problem. Further, it does not mention compensating in a distributed way. In regard to page 11, lines 31-33. This is discussing the first zone (depletion, not enrichment). It is not discussing the compensation of the enrichment of the channels, which is in the third zone. Claim 25 is dependent upon claim 11, which claims the enrichment of channels, which is done in the third zone. The applicant does not disclose using compensation in a distributed way in the third zone.

In regard to the applicant's arguments with regard to Saleh, the applicant argues elements, which are not claimed. The applicant argues that Saleh teaches "partitioning" the different wavelengths while the applicant "explained that energy transfers will be of different types in different wavelength regions, and each is compensated for in an appropriate way." Not only is this NOT

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CLAIMED, but also it appears to be similar to Saleh's partitioning into different wavelength bands.

The applicant argues that Saleh only teaches the band of 1520-1565 nm on page 5. It is unclear what the applicant means by this, Saleh specifically talks about using different bands (expanding to 1620 nm in column 8, lines 8-10 and using the C and L bands together; column 10, lines 33-42). From the applicant's specification, it appears that different bands are compensated in different ways. Saleh teaches compensating for different bands in different ways. The applicant teaches specific means which provide specific compensation. It is unclear to the examiner why the applicant's means (which are also taught by Saleh) provide a different function than those provided by the applicant. The question is not only whether it is obvious, but also if it is inherent that the applicant's means (for example a distributed amplifier) which provides a specific function, is also provided by Saleh. The applicant now has the burden to explain why each of the similar elements of Saleh do not provide the same function of the applicant's. The applicant's specification is vague as to how the elements provide such a function. This may shift more burdens on the applicant. Since the specification just says, for example, that distributed amplifiers compensate the first zone. It appears that this is well known or inherent. There does not appear to be any details. Therefore, it would appear that using distributed amplifiers (as taught by Saleh) would provide this function. It does not matter whether Saleh knew that he was compensating for specific problems, if he was inherently doing it. Further, if he selects amplifiers based on how they function in a particular band, it is obvious that he would select the amplifiers based on which band he is using and which would provide the best signal. On page 7,

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the applicant argues that applicant's Raman amplifier has had its gain set to compensate for the Raman effect. In the specification, it is not apparent that the amplification is SET. It appears that the applicant selects different types of amplifiers for different bands. This is what it appears that Saleh does. In regard to the arguments of Chraplyvy, Saleh teaches an upper band which can be used with other bands. Chraplyvy teaches compensating for the enrichment in upper part of a band. It would have been obvious to compensate for the upper part of the band of Saleh which would inherently have enrichments, with the teaching of Chraplyvy in order to avoid the noise caused by the enrichment.